REMARKS

This is a full and timely response to the non-final Office Action mailed on March 27, 2006. Through this response, claims 80, 85, and 96 have been amended, and claim 122 has been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and presently pending claims are respectfully requested. Applicants should not be presumed to agree with any statements made in the Office Action regarding the rejections and objections made in the Office Action unless otherwise specifically indicated by Applicants.

I. Response to Restriction Requirement

In response to the restriction requirement, Applicants respectfully affirm through this response the election to prosecute the claims of Group I, corresponding to claims 80, 82, 83, 85, 86 and 90-101, without traverse. Furthermore, Applicants have canceled claim 122 without prejudice, waiver, or disclaimer.

II. Claim of Priority

Applicants are not addressing the validity of all assertions made in the Office Action regarding the priority of this Application. Therefore, Applicants should be not presumed to agree with any statements made in the Office Action regarding the priority of the Application unless otherwise specifically indicated by Applicants.

III. Response to Claim Rejections Under 35 U.S.C. § 103

A. Statement of the Rejection

Claims 80, 82, 83, 85, 96, and 90-101 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Lawler et al.* ("*Lawler*," U.S. Patent No. 5,585,838) in view of *Russo*

("*Russo*," U.S. Patent No. 5,619,247), and further in view of *Tsumagari* ("*Tsumagari*," U.S. Patent No. 6,480,669). Applicant respectfully traverse this rejection, and further submit that the rejection has been rendered moot in view of the claim amendments.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

Although the rejection has been rendered moot by the claim amendments described above, Applicants respectfully submit that a *prima facie* case for obviousness is not established through the combination of *Lawler* in view of *Russo* and further in view of *Tsumagari*.

Independent Claim 80

Claim 80 recites (emphasis added):

80. A method implemented by a television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from the STT in a cable television headend, said method comprising steps of:

receiving via a tuner in the STT a video presentation provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation;

outputting by the STT at least a portion of the video presentation as a video-on-demand television signal;

receiving a first user input associated with bookmarking a visual scene contained in the video presentation, including receiving a character sequence to be assigned to the visual scene while the video presentation is being presented to the user;

storing information related to the visual scene in a memory of the STT responsive to receiving the first user input, including storing only in the memory of the STT information related to the visual scene in response to receiving the first user input, including storing only in the memory of the STT data corresponding to the character sequence in response to receiving the user input configured to assign the character sequence to the visual scene;

outputting by the STT at least another portion of the video presentation as a video-on-demand television signal;

receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion

of the video presentation;

responsive to receiving the second user input, requesting by the STT that the headend send the video presentation beginning from the requested visual scene;

receiving by the STT from the headend the video presentation beginning from the requested visual scene; and

outputting by the STT a video-on-demand television signal comprising a portion of the video presentation starting from a location corresponding to the visual scene responsive to the second user input, wherein the location corresponding to the visual scene is identified by the STT using the information related to the visual scene, including using information related to the visual scene stored only in the STT.

Although Applicants believe the rejection to be rendered moot in view of the above-described claim amendments, Applicants address the patentability of amended claim 80 in view of the pending rejection. In particular, Applicants respectfully submit that *Lawler* in view of *Russo* and further in view of *Tsumagari* does not disclose, teach, or suggest at least the above emphasized claim features, and thus Applicants respectfully submit that independent claim 80 is allowable over *Lawler* in view of *Russo* and further in view of *Tsumagari*.

Because independent claim 80 is allowable over the art of record, dependent claims 82-83, 85-86, and 90-95 are allowable as a matter of law for at least the reason that the dependent claims 82-83, 85-86, and 90-95 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally, Applicants do not believe the combination of *Lawler* in view of *Russo* and further in view of *Tsumagari* is obvious. In particular, *Lawler* appears to describe a headend

server-based VOD. For instance, col. 6, lines 1-6 and col. 16, lines 42-45 of *Lawler* provide as follows:

> [col. 6] The continuous media servers 32 provide storage and on-demand or near on-demand delivery of digitized video information.
>
> [col. 16]Other programs may include traditional video that is provided by a computer executed program such as a movies-on-demand service in which a processor at the head end retrieves stored video information and provides it to a viewer station.

There does not appear to be any discussion of client-based VOD (*e.g.*, personal video recording VOD), nor any disclosure of architecture, such as random access storage, among other components to enable client-based VOD. In contrast, *Russo* appears to be directed to client-based near VOD as a preferred embodiment or to intermediate storage of near VOD disposed between the headend and the client. For instance, col. 4, lines 28-44 provides as follows (emphasis added):

> In the preferred embodiment, the program storage unit 14 preferably is <u>located at the subscriber site.</u> However, in an alternative embodiment, the physical storage could be a part of a larger storage unit located at the cable transmission facility, or at one of several <u>intermediate storage facilities</u>, for example, serving groups of subscribers, located ill[sic] the transmission paths <u>between the cable transmission facility and the subscriber sites</u>. In this case, the subscriber would be allocated a specific portion of the overall storage capacity available, and would be able to use than storage capacity as desired. In this manner, the cable operation could

continue to offer programming in accordance with a predetermined schedule, but individual subscribers may choose to purchase the near-video-on-demand feature, if so desired. This would obviate the need for the cable system to be equipped to supply full video-on-demand service for all subscribers immediately.

The last sentence of the above-cited section would appear to argue or teach against a headend server based VOD implementation. Applicants respectfully submit that such a combination of disparate systems and problems to be solved offer opposing teachings and make the proposed combination of *Lawler* and *Russo* unobvious. With regard to the addition of *Tsumagari*, there is no mention of VOD in *Tsumagari*, which appears to emphasize local storage, unlike *Lawler*. Thus, Applicants respectfully submit that the use of *Tsumagar* in combination with *Lawler* and *Russo* also is not obvious, at least given the absence of any mention of headend server based VOD or client-based VOD implementations. Accordingly, Applicants respectfully submit that a *prima facie* case for obviousness is not established through the combination of *Lawler* in view of *Russo* and further in view of *Tsumagari*.

Independent Claim 96:

Claim 96 recites (with emphasis added):

96. A television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from the STT in a cable television headend, said STT comprising:

a tuner configured to receive a motion video presentation provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation;

a memory; and

a processor that is programmed to enable the STT to,

output at least a portion of the motion video presentation as a video-on-demand television signal,

store information related to a visual scene contained in the motion video presentation only in the memory of the STT responsive to the STT receiving a first user input associated with the visual scene, without stopping output of the motion video presentation, wherein the first user input includes a character sequence to be assigned to the visual scene, and wherein the information related to the visual scene includes data corresponding to the character sequence,

output at least another portion of the motion video presentation as a video-on-demand television signal,

receive a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the motion video presentation,

responsive to receiving the second user input at the STT, request that the headend send the motion video presentation beginning from the requested visual scene,

receive from the headend the motion video presentation beginning from the requested visual scene, and

output responsive to the STT receiving a second user input a video-on-demand television signal comprising a portion of the motion video presentation starting from a location corresponding to the visual scene, including using

information related to the visual scene stored only the memory of the STT, wherein the video-on-demand television signal comprising the portion of the motion video presentation starting from a location corresponding to the visual scene is output after the at least another portion of the motion video presentation is output as a video-on-demand television signal.

For similar reasons presented above in association with independent claim 80, Applicants respectfully submit that *Lawler* in view of *Russo* and further in view of *Tsumagari* does not disclose, teach, or suggest at least the above emphasized claim features. Accordingly, Applicants respectfully submit that independent claim 96 is allowable over the art of record.

Because independent claim 96 is allowable over the art of record, dependent claims 97-101 are allowable as a matter of law.

Further, for similar reasons presented above, Applicants respectfully submit that a *prima facie* case for obviousness is not established through the combination of *Lawler* in view of *Russo* and further in view of *Tsumagari*.

Additionally, with regard to the Official Notice on pages 11 (claim 93) and 15 (claim 100) as to the claim limitations pertaining to "'prompting [a user] to provide input' to select between available options," Applicants respectfully traverse this taking of Official Notice. The MPEP defines the standard with regard to taking official notice and "well-known" assertions. As provided in MPEP § 2144.03:

> Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable

> demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).
>
> As provided in MPEP § 2144.03 (emphasis added):
>
> If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Applicants respectfully submit that in the context of the claim language, such a taking of Official Notice is improper given the added complexity associated with such features incorporated from respective independent claims 80 and 96, and the balance of the claim features found in claims 93 and 100. Accordingly, Applicants traverse the taking of Official Notice. Because of this traversal, the Office must support its findings with evidence, or withdraw the well-known determination.

In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

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